

REMARKS

REJECTION UNDER 35 USC §112, ¶2

Amended claim 1, and those claims dependent thereon, are not indefinite under 35 USC §112, ¶2. The test for indefiniteness "requires a determination [as to] whether those skilled in the art would understand what is claimed when the claim is read in light of the specification" (*Morton International, Inc. v. Cardinal Chemical Co.*, 5 F.3d 1464, 28 USPQ2d 1190 (Fed. Cir. 1993), *on remand from*, 508 U.S. 83, 26 USPQ2d 1721 (1993)). Thus, the claim and the specification must be read keeping in mind the knowledge of those skilled in the art, and the understanding they would gain from such a reading.

In claim 1, the examiner asserts that the word "drying" is indefinite due to a lack of "basis for ascertaining the requisite degree of drying," and interprets this word to indicate that "any degree of solvent or water evaporation meets the limitation" (office action, p.2). This is not, however, the interpretation that one of skill in the art would place on the concept of "drying." We include herewith a definition of the word "drying", drawn from Hawley's Chemical Dictionary, which indicates that the term has a meaning of "[r]emoval of 90-95% of the water from a material" (p.428). This definition is not presented as a limitation to the present claims, but only to demonstrate that a significantly greater amount of evaporation, i.e., more than simply "any", is required to constitute "drying" to those of skill in the art. Applicants refer the examiner to the specification's examples for more detailed information as to the particular interpretation

of this term in relation to claim 1.

The other bases for rejection under this section have been obviated through amendment to claim 1. Applicants respectfully request that this rejection be withdrawn.

#### REJECTION UNDER 35 USC §103(A)

The rejection of claims 1, 2 and 4 under 35 USC §103(a) does not account for various differences between the reaction disclosed in Wingert et al. (US 5,221,762) and that of the present claims. To make a claim obvious, either the prior art reference or some teaching in the art must suggest or give motivation to modify the prior art invention in such a way as to arrive at the presently claimed invention. All of the claim limitations must be accounted for, and all differences must be addressed.

In the present case, the examiner asserts that Wingert discloses a process for preparing E-oxime ethers in which phenoxymethyl benzoic acids are created as intermediates (office action, p.3). It is further asserted that Wingert carries out (or at least suggests) reaction of phenolate and phthalide in the presence of a solvent and "in the melt" (*id*). Thus, the conclusion of the examiner is that inherently, methanol or ethanol would evaporate, and cites Wingert as stating that this reaction is made with simultaneous removal of solvent (*id*). However, this characterization of Wingert glosses over the particular facts of the reaction and thus misses essential differences when it is compared with the presently claimed invention.

In Wingert,

- a) a phenol is converted into its phenolate using a *base*, in the presence of a diluent,
- b) the phenolate is then mixed with a lactone, and
- c) the mixture is reacted at an elevated temperature which also removes the diluent by distillation.

These steps result in the formation of a 2-phenoxyethylbenzoate solution. There is no 2-phenoxyethylbenzoic acid present in step c) of Wingert's disclosure. In the subsequent step,

- d) the liquid melt of 2-phenoxyethylbenzoate is dissolved in water *and acidified* "resulting [in] 2-phenoxyethylbenzoic acid," which is then
- e) converted into the corresponding 2-phenoxyethylbenzoyl chloride,

and so forth (Wingert, col.1:41-col.2:13; col.11:56-col.12:13).

The production of 2-phenoxyethylbenzoic acid in Wingert requires stopping the benzoate-producing reaction, acidifying the benzoate into the corresponding benzoic acid, and then performing "[s]ubsequent workup [of the 2-phenoxyethylbenzoic acid] by conventional means" (col.12:57-58). The main point of the present invention is to *avoid* the difficulties encountered when the conventional means of subsequent workup is employed. Wingert's equivalent European Patent, EP-A 463 711, is cited, and the difficulties it presents are discussed, in the current specification (at p.1:31-42).

The examiner's comparison of the disclosure of Wingert and the claims of the present invention do not accurately reflect the reaction steps employed. When these steps are compared as above, the difference in treatment of the benzoic acid solution is apparent. Wingert briefly states that the benzoic acid is "washed with a little water" (col.14:17), but this does not in any way suggest the presently claimed invention.

Applicants respectfully request that this rejection be withdrawn. In view of the foregoing amendments and remarks, applicants consider that the rejections of record have been obviated and respectfully solicit passage of the application to issue.

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Respectfully submitted,  
KEIL & WEINKAUF

A handwritten signature in black ink, appearing to read 'David C. Liechty', with a large, stylized flourish extending to the right.

David C. Liechty  
Reg. No. 48,692

1350 Connecticut Ave., N.W.  
Washington, D.C. 20036  
(202)659-0100

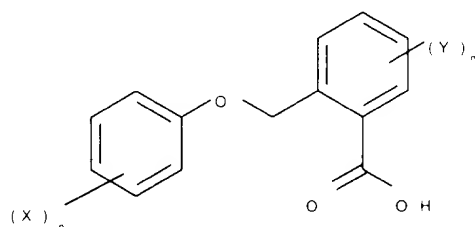
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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS**

Amend claim 1 to read as follows:

1. (amended) A process for drying phenoxymethylbenzoic acids of the general formula I



where X, Y, m and n have the following meanings:

X [,] and Y are, independently, a halogen or a C-organic radical,

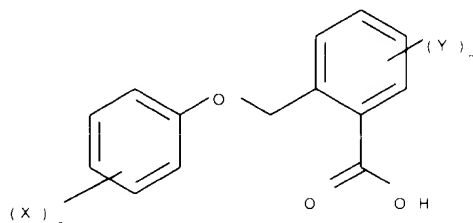
m has a value from 0 to 4 and

n has a value from 0 to 5

which comprises drying the water- and/or solvent-wet phenoxymethylbenzoic acids at a temperature in the range from 1° to 25°C above their melting point under the [reaction conditions used] drying conditions employed.

**COPY OF ALL CLAIMS**

1. (amended) A process for drying phenoxyethylbenzoic acids of the general formula I



where X, Y, m and n have the following meanings:

X and Y are, independently, a halogen or a C-organic radical,

m has a value from 0 to 4 and

n has a value from 0 to 5

which comprises drying the water- and/or solvent-wet phenoxyethylbenzoic acids at a temperature in the range from 1° to 25°C above their melting point under the drying conditions employed.

2. A process as claimed in claim 1, wherein the drying is carried out at temperatures in the range from 130° to 240°C under atmospheric pressure.
3. A process as claimed in claim 1, wherein solvent residues are partly removed by washing with water before drying.
4. A process as claimed in claim 1, wherein a phenoxyethylbenzoic acid with a water and/or solvent content of from 0.1 to 50% by weight is employed.